

REMARKS

1. Request for Withdrawal of Finality

The Examiner has issued a final Office Action. However, the Examiner has not addressed each and every element of at least independent claims 30 and 48. Specifically, at least independent claims 30 and 48, as well as their respective dependent claims, require a three video display gaming machine with each video display screen having a particular function. The Examiner has not shown or disclosed any such device in the two cited references, Giobbi and Marnell. Indeed, the Examiner readily admits that "Marnell is silent ... regarding multiple display devices." See Page 3 of final Office Action. Further, the Examiner readily admits that Giobbi only "discloses a primary screen displaying a game being played by a player and a secondary screen/display displaying a secondary game play feature." See Page 4 of final Office Action. Otherwise stated, Giobbi only includes two video display screens.

Thus, the Examiner has freely admitted that neither Marnell nor Giobbi teaches or suggests a three video display gaming machine. In contrast, the invention of claim 30 clearly requires: (1) a first video display displaying a first game located on the stand-alone gaming machine; (2) a second video display displaying pay tables associated with the first game located on the stand-alone gaming machine; and (3) a third video display displaying artwork associated with the first game located on the stand-alone gaming machine. Each of the reconfigurable video display screens provide specialized functions (game play, pay tables for the game, and theme artwork associated with the game, respectively) that enable a gaming machine to be completely transformed, both in function and appearance, from one game theme to another game theme. Otherwise stated, not only does the claimed invention remove the time consuming process of changing EPROMS (or other memory storage devices), it also removes the time consuming process of changing glass with silk screen artwork (or other physical artwork) typically attached directly on a gaming machine cabinet itself. As such, due to the complete lack of any mention of this limitation in the cited references, Applicants submit that a final Office Action is not proper in this situation and request withdrawal of the finality of the Action.

2. Claim Rejections – 35 U.S.C. §103(a) – Claims 1-20, 30-46, 48-50, and 57-59

Claims 30-45 and 48 are pending in the present application. The Examiner has rejected claims 1-20, 30-46, 48-50, and 57-59 under 35 U.S.C. 103(a) as being unpatentable over Giobbi (US 2002/0107072) in view of Marnell (USPN 5,393,057). Applicants respectfully traverse this rejection. Claims 1-20, 46, and 49-50, and 57-59 have been canceled. In order to provide clarification only, claims 30, 38, and 48 have been amended. Claims 30, 38, and 48 are independent claims. Claims 31-37 depend from independent claim 30; claims 39-45 depend from independent claim 38. For brevity, only the bases for the rejection of the independent claims are traversed in detail on the understanding that dependent claims are also patentably distinct over the cited references as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

The Examiner has stated that the claimed invention is unpatentable over Giobbi in view of Marnell. However, the Giobbi and Marnell references do not teach or suggest, either alone or in combination, the claimed elements of independent claims 30, 38 (as amended), or 48. As described above, independent claims 30, 38 (as amended), and 48, as well as their respective dependent claims, require a three video display gaming machine with each video display screen having a particular function. The Examiner has not shown or disclosed any such device in its two cited references, Giobbi and Marnell. Indeed, the Examiner readily admits that “Marnell is silent ... regarding multiple display devices.” See Page 3 of final Office Action. Further, the Examiner readily admits that Giobbi only “discloses a primary screen displaying a game being played by a player and a secondary screen/display displaying a secondary game play feature.” See Page 4 of final Office Action. Otherwise stated, Giobbi only includes two video display screens.

Thus, the Examiner has freely admitted that neither Marnell nor Giobbi teaches or suggests a three video display gaming machine. In contrast, the invention of claim 30 clearly requires: (1) a first video display displaying a first game located on the stand-alone gaming machine; (2) a second video display displaying pay tables associated with the first game located on the stand-alone gaming machine; and (3) a third video display displaying artwork associated with

the theme of the first game located on the stand-alone gaming machine. Each of the reconfigurable video display screens provide specialized functions (game play, pay tables for the game, and theme artwork associated with the game, respectively) that enable a gaming machine to be completely transformed, both in function and appearance, from one game theme to another game theme. Accordingly, not only does the claimed invention remove the time consuming process of changing EPROMS (or other memory storage devices), it also removes the time consuming process of changing glass with silk screen artwork (or other physical artwork) typically attached directly on a gaming machine cabinet itself. As such, due to the complete lack of any mention of this limitation in the cited references, Applicants submit that the 35 U.S.C. §103(a) of claims 30-45 and 48 has been overcome.

#### Improper Combination of References

The Examiner has stated that “the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” The Examiner has argued that the two games (i.e., primary game and secondary game) included in the Marnell reference could be combined with the reconfiguration element of the Giobbi reference (i.e., the reconfiguration of a first game into a second game that is downloaded from a server). However, this proposed modification would render the Marnell reference unsatisfactory for its intended purpose, since the Marnell reference requires the secondary game to work in conjunction with an output of the primary game, in contrast to a first game being reconfigured into a second game.

Respectfully, Applicants wish to point out to the Examiner that the Manual of Patent Examining Procedure, § 2143.01, states “The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose.” Accordingly, both the primary game and the secondary game must exist and work in conjunction with each other in the Marnell reference, in stark contrast the reconfiguration of a first downloaded independent game into a second downloaded independent game. Thus, in accordance with M.P.E.P. § 2143.01, the teachings and suggestions of the Marnell reference and the Giobbi reference CANNOT be combined.

Moreover, in the Marnell reference, a plurality of poker gaming devices or slot machines are electrically coupled to a common bingo gaming device for simultaneous linked play of a

single bingo game by a plurality of players, each of whom plays his or her own individual poker game. Thus, modifying the Marnell reference, that includes a primary game and an interconnected secondary game in which the secondary game is linked in direct competitive “head-to-head” play against other players, into the reconfigurable, downloadable, single game, non-direct competitive play machine of the Giobbi reference, would change the principle of operation of the reference. Respectfully, the Manual of Patent Examining Procedure, § 2143.01, clearly states that “The Proposed Modification Cannot Change The Principle Of Operation Of A Reference.” Thus, in accordance with M.P.E.P. § 2143.01, the teachings and suggestions of the Marnell reference and the Giobbi reference CANNOT be combined.

The Marnell reference relates to an electronic gaming apparatus that couples an electronic primary gaming device to an electronic secondary gaming device. Specifically, in the Marnell invention, an “electronic poker gaming device is electrically coupled to the electronic secondary gaming device, and the primary gaming device is responsive to the occurrence of selected events, such as poker hands or slot machine reel combinations, for input into the secondary gaming device. Thus, the occurrence of poker hands in the poker gaming device produces selection of a space in the bingo matrix of a bingo-type gaming device. A plurality of poker gaming devices or slot machines can be electrically coupled to a common bingo gaming device for simultaneous play of a single bingo game by a plurality of players, each of whom is playing his or her own individual poker game.” See Abstract.

Referring now to the Giobbi reference, the Examiner states, “Giobbi teaches a gaming system in which video content is capable of being reconfigured in response to various triggers.” However, the Giobbi reference discloses a gaming system in which a game is executed on a game execution server and then transmitted via a network connection to a dumb terminal that merely displays the game activity that is being executed on the remote game execution server. In an alternate embodiment of the Giobbi invention, a game is downloaded, in response to a player request, from a master game server to a requesting remote display terminal where the game is locally executed by the terminal.

As explained above, the Marnell reference overwhelmingly teaches the use of a primary game and an interconnected secondary game in which the secondary game is linked in direct competitive “head-to-head” play against other players, while the Giobbi reference is cited for its

teaching of reconfigurable, downloadable, single game, non-direct competitive play machine. Since a primary game and an interconnected secondary game in which the secondary game is linked in direct competitive “head-to-head” play against other players is incompatible with reconfigurable, downloadable, single game, non-direct competitive play machine, these two references teach dramatically away from each other. In such a situation, it is improper to combine references where the references teach away from their combination. The Manual of Patent Examining Procedure, § 2145, sub§ 2, states that “References Cannot Be Combined Where Reference Teaches Away from Their Combination.” Thus, in accordance with M.P.E.P. § 2145, sub§ 2, the teachings and suggestions of the Marnell reference and the Giobbi reference CANNOT be combined.

In conclusion, none of the cited references, either alone or in combination, teach or suggest each and every element of the claimed invention. Specifically, none of the cited references teach or suggest: (1) a first video display displaying a first game located on the stand-alone gaming machine; (2) a second video display displaying pay tables associated with the first game located on the stand-alone gaming machine; and (3) a third video display displaying artwork associated with the theme of the first game located on the stand-alone gaming machine. Furthermore, none of the cited references teach or suggest that the video content for a different game of chance is used to reconfigure the gaming machine in response to a reconfiguration command from a remote location. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claims 30-45 and 48 has been overcome.

CONCLUSION

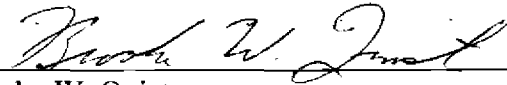
Applicants have made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the differences between the claimed invention and the cited references are such that the claimed invention is patentably distinct over the cited references. Therefore, reconsideration and allowance of all of Applicants' claims 30-45 and 48 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge any additional required fees from Deposit Account No. 502811, Deposit Account Name Brown Raysman Millstein Felder & Steiner LLP.

If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8319. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 6:30 PM Pacific Time.

Respectfully submitted,

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